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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,281	10/24/2005	Gunter Fuhr	46955.23	8505
23973 7590 10/21/2008 DRINKER BIDDLE & REATH ATTN: INTELLECTUAL PROPERTY GROUP ONE LOGAN SQUARE 18TH AND CHERRY STREETS PHILADELPHIA, PA 19103-6996				
EXAMINER				
MACAULEY, SHERIDAN R				
ART UNIT		PAPER NUMBER		
1651				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/532,281

Applicant(s)

FUHR ET AL.

Examiner

SHERIDAN R. MACAULEY

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 1-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The response and amendment received on June 26, 2008 have been entered. All evidence and arguments have been fully considered. Claims 1-18 are pending. Claims 1-14 have been withdrawn due to a previous requirement for restriction. Claims 15-18 are examined on the merits in this office action.

Claim Rejections - 35 USC § 102/103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 15-18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fuhr et al. (WO02/46719, see US 2004/0065093 for English translation; both references are cited in the prior action). Claim 15 recites a method for storage of at least one suspension specimen in a low-temperature state in a carrier comprising the steps of: accommodating the at least one suspension specimen in at least one specimen chamber made of a flexible material that is elastically deformable at room temperature; positioning the specimen chamber in a first frame part of a mounting frame of a carrier, the mounting frame comprising said first frame part and a second frame part, said frame parts adapted for assembling together detachably using one or more connecting elements; connecting the first and second frame parts into an assembled state wherein the first and second frame parts come into contact on side faces of the frame parts and with the specimen chamber, wherein the specimen chamber is securely clamped between the first and second frame parts such that it is immovable relative to the mounting frame; and converting the suspension

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specimen to a low-temperature state by positioning the carrier with the specimen chamber in cryomedium. Claim 16 recites the method of claim 15, wherein each specimen chamber comprises at least one inlet end and one outlet end, and at least one suspension specimen is inserted into a corresponding specimen chamber by immersing the inlet end of the corresponding specimen chamber into a specimen reservoir and transferring the suspension specimen under the influence of a vacuum applied to the corresponding outlet end of the specimen chamber, or under the influence of capillary forces. Claim 17 recites the method of claim 15, wherein at least one partial specimen is detached from the at least one specimen chamber in the low temperature state by mechanical separation. Claim 18 recites the method of claim 17, wherein the mechanical separation comprises cutting off chamber sections of the specimen chamber adjacent to the frame parts of the carrier.

7. Fuhr teaches a method for storage of a suspension specimen in a low-temperature state in a carrier comprising accommodating the specimen in a specimen chamber that may be made of a flexible material (note that Fuhr discusses the use of a meandering hose that may be closed by clamping together and states that, alternately, a rigid tube may be used; see English translation, p. 7, par. 82-83), positioning the specimen chamber in a first frame part of a mounting frame of a carrier, which comprises a first and second frame part, which are adapted for assembling together detachably using one or more connecting elements, connecting the first and second frame parts into an assembled state wherein the first and second parts come into contact on side faces with the specimen chamber, such that the specimen chamber is

immovable relative to the mounting frame, and converting the specimen to a low-temperature state by positioning the carrier with the specimen chamber in a cryomedium (see English translation, figs. 17, 18, 21-24, p. 3, par. 24, p. 4, par. 48-49, p. 8, par. 88, 91). Fuhr teaches the positioning of the flexible material between a first a second part of the mounting frame (see for example, fig. 17) and the closure of the tubes by clamping at a location between parts of the mounting frame (see again fig. 17 at 614 and p. 7 par. 82). The specimen chambers of Fuhr may comprise an inlet end and an outlet end and may be filled with a suspension specimen by placing the inlet end into a specimen chamber and applying reduced pressure to the outlet end (i.e. the chamber is filled by application of a vacuum or by capillary forces; fig. 21, see English translation, p. 8 par. 88). In the method of Fuhr, at least one partial specimen may be detached from the specimen chamber in the low-temperature state by mechanical separation, such as cutting off chamber sections of the specimen chamber adjacent to frame parts of the carrier (see English translation, figs. 21, 22, p. 5, par. 60, p. 7, par. 80, p. 8, par. 90). Therefore, Fuhr anticipates all of the limitations of the cited claims.

8. Alternately, if Fuhr is not found to anticipate the claims because, as applicant argues, the reference does not specifically set forth the clamping of the specimen chamber between a first and second frame part of the mounting frame, the claims are rendered obvious in view of Fuhr. The reference teaches the positioning of the flexible material between a first a second part of the mounting frame (see for example, fig. 17) and the closure of the tubes by clamping at a location between parts of the mounting frame (see again fig. 17 at 614 and p. 7 par. 82). Fuhr also teaches the construction of

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mounting frames that can be assembled together detachably (see for example, fig. 13). One of ordinary skill in the art would have been motivated to modify the teachings of Fuhr to arrive at the claimed invention because a method for storage of a specimen in a carrier comprising nearly all of the claimed elements was known at the time of the invention. It was further known that mounting frames for use in such a method could be used with flexible specimen chambers that could be sealed on a mounting frame by clamping. One of ordinary skill in the art would therefore have recognized the advantageousness of combining a clamping mechanism with a part of the mounting frame and could have performed such a method with a reasonable expectation of success. It would therefore have been obvious for one of ordinary skill in the art to modify the teachings discussed above to arrive at the claimed invention.

9. Thus, the claims are anticipated by or, in the alternative, are rendered obvious by the cited reference.

Response to Arguments

10. Applicant's arguments filed June 26, 2008 have been fully considered but they are not persuasive. Applicant argues that Fuhr does not anticipate or render obvious the instant claims because the reference does not teach a first and second part of the mounting frame wherein the specimen chamber may be securely clamped between the first and second frame parts. In response to this argument, it is noted that the reference discloses mounting frames that may have a first and a second part, such as in fig. 13. Furthermore, the assemblage of such a frame comprising attached parts would have

been inherent to or a routine modification of the frame of Fuhr (see for example, figs. 17 and 18). Fuhr discloses the clamping of the flexible specimen chambers on the mounting frame (p. 7, par. 82); however, the reference is unclear regarding the inclusion of the clamping mechanism as a part of the mounting frame or as a separate part. However, one of ordinary skill in the art would therefore have recognized the advantageousness of combining a clamping mechanism with a part of the mounting frame and could have performed such a method with a reasonable expectation of success. The claims are therefore anticipated by or, in the alternate, rendered obvious in view of Fuhr. Thus, applicant's arguments have been fully considered, but they have not been found to be persuasive.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHERIDAN R. MACAULEY whose telephone number is (571)270-3056. The examiner can normally be reached on Mon-Thurs, 7:30AM-5:00PM EST, alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on (571) 272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SRM
/Ruth A. Davis/
Primary Examiner, Art Unit 1651